

REMARKS

Unreturned 1449 Form

Applicant again respectfully brings to the Examiner's attention that the IDS form 1449 submitted in July of 1999 has not yet marked and returned by the Examiner although corresponding return post card was stamped as received by OIPE on July 19, 1999. Because the Examiner has not acknowledged Applicant's last two requests on this issue, Applicant will contact the Examiner by phone about re-submitting the 1449 form.

Amendments

Amendments to the Claims

Applicant has amended claims 11, 21 and 36 to more particularly point out that the claimed invention presents a menu to a viewer that comprises indications of viewer interest and disinterest in viewing the broadcast of a program. No new matter has been added as a result of these amendments.

Rejections

Rejections under 35 U.S.C. § 103

Claims 11-18, 21-33, 36, 37, 43-48, 50-52 and 58-60

Claims 11-18, 21-33, 36, 37, 43-48, 50-52 and 58-60 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent 5,699,107 to Lawler et al. in view of U.S. Patent 5,583,560 to Florin et al., U.S. Patent 5,659,653 to Diehl et al., and U.S. Patent 5,859,662 to Cragun et al. Applicant reserves the right to challenge the designation of Cragun as prior art because Cragun issued after Applicant's filing data. Again, Applicant respectfully reminds the Examiner that claim 33 was cancelled in the preliminary amendment for the CPA submitted on March 6, 2003. Accordingly, Applicant omits claim 33 from the following arguments.

Applicant respectfully submits that the combination of Lawler, Florin and Diehl cannot render Applicant's invention obvious because the combination does not teach each and every element of the invention as claimed in claims 11-18, 21-32, 36, 37, 43-48, 50-52 and 58-60.

Florin discloses displaying an icon on a broadcast advertisement that, when activated, shows the viewer additional information about the advertised product. The advertisement, icon, and the additional information are generated remotely from the viewer.

Lawler discloses scheduling a reminder to notify a viewer of the broadcast of a program previously selected by the user from an electronic program guide (EPG). The EPG and the reminder are generated remotely from the viewer.

Diehl discloses a system that extracts information from a broadcast signal to set a VCR to record a program when the user presses a "learn" button during an advertisement for the program. The advertisement, broadcast signal and information are generated remotely from the viewer.

Cragun discloses a system local to a viewer that searches text in a broadcast signal for keywords or phrases input by a user. When in an automatic scan mode, the system saves the corresponding segment of the broadcast program for later use by the viewer but does not notify the user that a matching segment has been found. Instead, the user accesses the list of saved segments when the user manually activates the system. When in a manual search/edit mode, Cragun's system searches the previously-saved program and notifies the viewer when it finds a matching segment. Cragun discloses that only small segments of a broadcast signal can be searched in manual search/edit mode because of the amount of time needed to decode and search the closed captioning portion of the broadcast signal.

In support of the combination, the Examiner is urging various modifications to the references to make them fit together and operate as Applicant's claimed invention. Among other modifications, Florin must be modified to generate a signal to indicate viewer interest instead of displaying additional information to the viewer when the viewer activates the icon during the broadcast of an advertisement for an upcoming program. Lawler must be modified to automatically set a reminder based on the signal from Florin instead of allowing the user to manually set the reminder by selecting a program from the EPG. Diehl must be modified to extract locally stored information instead of remotely stored program information. It is unclear from the Examiner's arguments what signal now triggers Diehl's extraction. Is it the signal from Florin or is it the reminder from Lawler?

In addition, both Florin and Lawler have to be modified to generate the icon and reminder locally in order to be equivalent to Applicant's claimed first and second notifications. The Examiner is citing Cragun as providing the suggestion for this particular modification. However, Cragun neither teaches nor suggests generating an icon during a broadcast, nor generating a program reminder. The Examiner motivates the entire combination by stating it would "provid[e] a number of impulse program choices to the user." Both Lawler and Cragun disclose deliberate, manual input from the user and thus contain no suggestion that allowing the user an impulse choice would be advantageous. The incomplete reasoning of the Examiner and the lack of a clearly supported motivation indicate that the Examiner is selectively extracting elements from the prior art and arranging them to fit Applicant's claimed invention. This is improper hindsight and thus the combination is improper.

Furthermore, none of the references teach or suggest a first notification that is issued in response to a first signal generated by a viewer during the broadcast of advertisement of a program and that presents a menu of indications of viewer interest and disinterest in viewing the broadcast of the program as claimed by Applicant. Additionally, none of the references teach or suggest a second signal indicating a viewer menu selection that is generated in response to the first notification as claimed by Applicant.

Because the combination of Lawler, Florin, Diehl and Cragun is improper and also fails to teach or suggest each and every element of Applicant's invention as claimed in pending claims 11-18, 21-32, 36, 37, 43-48, 50-52 and 58-60, Applicant respectfully requests the withdrawal of the rejection of the pending claims under 35 U.S.C. § 103(b) over the combination.

Claims 49 and 57

Claims 49 and 57 stand rejected under 35 U.S.C. § 103(a) over the combination of Lawler, Florin, Diehl and Cragun in further view of Hendricks. Applicant respectfully submits that the combination cannot render Applicant's invention obvious because the base combination of Lawler, Florin, Diehl and Cragun is improper and nothing in Hendricks provides a proper motivation for the base combination. Furthermore, claims 49 and 57 depend from claims 21 and 36, respectively, and Hendricks does not teach the

claimed limitations that are missing from the base combination. Therefore, the combination of Lawler, Florin, Diehl and Hendricks cannot render obvious claims 49 and 57, and Applicant respectfully requests the withdrawal of the rejection of the claims under 35 U.S.C. § 103 over the combination.

SUMMARY

As a result of this preliminary amendment, claims 11-18, 21-32, 36-37, 43-52 and 57-60 are currently pending. In view of the foregoing amendments and remarks, Applicant respectfully submits that the pending claims are in condition for allowance. Applicant respectfully requests reconsideration of the application and allowance of the pending claims.

If the Examiner determines the prompt allowance of these claims could be facilitated by a telephone conference, the Examiner is invited to contact Sue Holloway at (408) 720-3476.

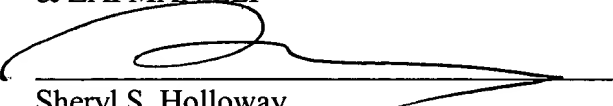
Deposit Account Authorization

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Applicant hereby requests such extension.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR
& ZAFMAN LLP

Dated: Jan. 8, 2004


Sheryl S. Holloway
Attorney for Applicant
Registration No. 37,850

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(408) 720-3476